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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/654,556	09/02/2003	Mike Thomas Goulet	19,693	5107
23556	7590	02/17/2006	EXAMINER	
KIMBERLY-CLARK WORLDWIDE, INC.			CORDRAY, DENNIS R	
401 NORTH LAKE STREET			ART UNIT	
NEENAH, WI 54956			PAPER NUMBER	
			1731	

DATE MAILED: 02/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/654,556	GOULET ET AL.	
	Examiner	Art Unit	
	Dennis Cordray	1731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-53 is/are pending in the application.
- 4a) Of the above claim(s) 1-15 and 46-53 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16-45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>7 docs.</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Applicant's election without traverse of Invention II (Claims 16-45) drawn to a product in the reply filed on 2/6/2006 is acknowledged.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 19, 21-23, 33, 35, 41 and 43-45 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 19, 21, 33 and 35 recite "...cured binder composition on the first outer surface is different than the cured binder composition on the second outer surface..."

Claims 41 and 43 recite "...cured binder composition on the first inner surface is different than the cured binder composition on the second inner surface..." The meaning of the word "different" is not clear. Does each binder composition have different epoxy reactive and/or epoxy functional groups; are the compositions cured at different temperatures; are they applied to the surfaces in different amounts or by different means; is each composition applied in a different pattern?

Claims 22 and 23 recite the limitation "the binder network" in Claim 16. There is insufficient antecedent basis for this limitation in the claim.

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Claims 44 and 45 appear to be duplicates of Claims 36 and 37. For the purpose of this examination, it is assumed that Claim 44 refers to Claim 38 rather than to Claim 30.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 16-22, 24-38 are rejected under 35 U.S.C. 102(a and e) as being anticipated by Merker et al (6500289).

Merker et al discloses a fibrous sheet that can be a paper towel (Abstract; col 1, line 21). The sheet can wet laid or air laid (col 5, lines 41-42) and can have a cured binder solution topically applied by printing in a pattern to one or both outer surfaces (col 4, lines 45-50; col 8, lines 37-39). The binder solution can be a different material for each surface and can be applied in a different networked pattern to each surface (col 8, lines 63-67; col 9, lines 1-9). The binder is applied to 15-60% of each surface (col 9, lines 53-59). The binding material results from the crosslinking reaction of a multifunctional epoxy resin (epoxy functional polymer) and a polymeric amine (epoxy-reactive polymer) (col 10, lines 59-63; col 11, lines 31-47). The binder solution is

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applied in a pattern of regularly spaced deposits (col 14, lines 30-40). Merker also discloses that the fibrous sheet can be two or more layers (col 5, lines 32-36). Where more than two layers are formed and the binder solution is applied to the outer surfaces after sheet formation, it is inherently not applied to at least one surface of an inner layer.

The fibrous sheets disclosed by Merker et al can have the claimed increase in wet/dry tensile strength ratio because, where the claimed and prior art apparatus or product are identical or substantially identical in structure or composition, a *prima facie* case of either anticipation or obviousness has been established. *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977). In other words, when the structure recited in the reference is substantially identical to that of the claims, the claimed properties or functions are presumed to be inherent.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 38-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Merker et al in view of Salmeen et al (4610743).

Merker et al does not disclose that the binder is applied to the inner surfaces of the two outer plies of a multilayer paper towel.

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Salmeen et al teaches that it is common to bind multiple plies of a paper product by applying a binding liquid to one or more of the plies then pressing the plies together in the nip between two calendar rolls (col 1, lines 66-68; col 2, lines 1-2). Salmeen et al also discloses a multi-ply paper product wherein the plies can be brought together in different locations in the papermaking process and wherein one or more of the plies can have a pattern of binder solution printed onto one or more sides via a gravure or impression roller (col 12, lines 48-68; col 13, lines 1-13).

The art of Merker et al, Salmeen et al and the instant invention are analogous as pertaining to multi-ply paper products comprising a binder solution. It would have been obvious to one of ordinary skill in the art to apply the binder solution to inner surfaces of the outer plies of the paper product of Merker et al in view of Salmeen et al to facilitate binding of the layers together.

Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Merker et al in view of Larson et al (6129815).

Merker et al does not disclose spraying the binder in a random pattern.

Larson et al discloses a multi-layered towel comprising a binder (Abstract). Larson et al also discloses that the binder can be applied to the a surface of the towel by rotogravure printing, flexographic means or spraying and that the pattern is such that the binder occupies from 15-60% of the area of the web (col 12, lines 48-58). Spraying inherently results in a random pattern of dots.

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The art of Merker et al, Larson et al and the instant invention are analogous as pertaining to multi-ply paper products comprising a binder solution. It would have been obvious to one of ordinary skill in the art to apply the binder solution by spraying to the paper product of Merker et al in view of Larson et al as a functionally equivalent option.

Double Patenting

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 44 and 45 are objected to under 37 CFR 1.75 as being a substantial duplicate of claims 36 and 37. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claims 16-37 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 22-35, 42 and 48-54 of copending Application No. 10/893209. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 38-45 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 55-62 of copending Application No. 10/893209. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the copending application and the instant claims are related as genus and species. Specifically, claim 55 of the copending application recites "a multi-ply paper towel comprising two outer plies...wherein one or both inner surfaces comprise a topically-applied network of a cured binder composition..." Claim 38 of the instant application recites "a multi-ply paper towel comprising two outer plies...wherein both inner surfaces comprise a topically-applied network of a cured binder composition..." The cured binder

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compositions are the same in both applications. Claims 39-45 read the same as Claims 56-62 of the copending application with appropriate reference changes.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 16-32 and 30-45 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 12 and 21-46 of copending Application No. 10/893094. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims and the claims of the copending application are related as genus and species. Specifically the instant claims refer to fibrous sheet or multi-ply paper towels comprising a topically-applied network of a cured binder composition resulting from the cross-linking reaction of an epoxy-reactive polymer and an epoxy-functional polymer. The copending claims refer to fibrous sheet or multi-ply paper towels comprising a topically-applied network of a cured binder composition resulting from the cross-linking reaction of an azetidinium-reactive polymer and an azetidinium-functional polymer. The azetidinium-reactive polymers are the same as the epoxy-reactive polymers and the azetidinium-functional polymers are epoxy-functional polymers (see pp 3-4 of the disclosure of the copending application). The instant and copending dependent claims recite the same limitations.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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Conclusion


The prior art made of record and not relied upon is considered pertinent to applicant's disclosure [DiStefano et al (4859527), Anderson et al (5196470), Satgurunathan et al (5547710), Bower (5614597), Barglik-Chory et al (6140419), Papalos et al (6303672), Wisneski et al (6533978), Howle et al (US 2003/0079847), Hu et al (US 2003/0121627), Li et al (6608237), DiStefano et al (EP-0247539)]. They pertain to other absorbent sheets comprising a binder and to self-curable epoxy compositions.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis Cordray whose telephone number is 571-272-8244. The examiner can normally be reached on M - F, 7:30 -4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Griffin can be reached on 571-272-1189. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


DRC


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